

## REMARKS

**Remaining Claims**

Nine (9) claims (Claims 10 – 18) remain pending in this application.

**Claims Rejections under 35 U.S.C §103**

Claims 10 – 18 stand rejected under 35 USC §103(a) as being unpatentable over *Smith* (US 7,067,547). For the following reasons, the Examiner's rejection is respectfully traversed.

Applicants respectfully submit that a prima facie case of obviousness has **not** been established.

The cited reference does not teaches or suggest all the claim limitations. The cited reference neither discloses nor suggests anything about an aqueous solution for disinfecting a contact lens, comprising: from 0.1 to 10 ppm of a microbicide selected from the group consisting of polyhexamethylene biguanide and alexidine; and 0.001 to 0.2 mol/L of 1,3-bis(tris[hydroxymethyl] methylamino)propane or a salt thereof as buffering agent, wherein the aqueous solution buffered by 1,3-bis(tris[hydroxymethyl] methylamino)propane is characterized by having a disinfecting efficacy that is at least 1.0 log of reduction greater than a disinfecting solution containing the same amount of the microbicide but buffered with a phosphate buffer, wherein said solution has a pH of 6.8 to 7.5.

Examiner requests unexpected and nonobvious results in comparison to the closest prior art to support the patentability of the present invention in her office action dated October 9, 2007. Clearly, the **unexpected result** and the **synergy** effect (Table 5) of the utilizing polyhexamethylene biguanimide/alexidine salts and 1,3- Bis-Tris Propane was unknown to Smith, especially since there is no evidence that Smith ever made or suggested a contact lens solution that contained polyhexamethylene biguanimide/alexidine salts and 1,3- Bis-Tris Propane. In contrast, all examples provided by the cited reference use phosphate as buffer columns 2 and 3).

The cited reference does not appreciate the present invention, i.e. **unexpected and beneficial finding** that disinfecting solutions buffered with 1, 3-bis(tris[hydroxymethyl]methylamino)propane and which also contain certain microbicides and fungicides exhibit a synergy resulting in a microcidal activity significantly higher than the activity of these same active ingredients used in conjunction with other buffers (page 3, lines 18-22) as shown in examples 1, 2

and 3 at pages 10-13. Without such appreciation of the invention, there is no teaching or desirability to modify the cited reference to arrive the present invention.

Examiner asserts that "the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious". This is not true because, as mentioned earlier, there is no evidence that Smith ever made or suggested a contact lens solution that contained polyhexamethylene biguanimide/alexidine salts and 1,3- Bis-Tris Propane. What the cited reference discloses is a laundry list of useful preservative components (at least 7 compounds and the like and mixtures thereof) including polyhexamethylene biguanimide/alexidine salts. Obviousness, however, may not be established by **probabilities or possibilities**. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Let alone, the cited reference does not know the **unexpected result** or **synergy** effect (Table 5) of the utilizing polyhexamethylene biguanimide/alexidine salts and 1,3- Bis-Tris Propane.

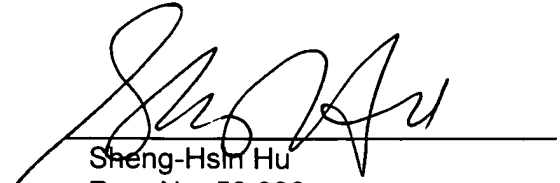
At least for the reasons given above, Applicants respectfully submit that Smith (U.S. 7,067,547) does not render the present invention obvious. As such, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection over claims 10-18.

### **CONCLUSION**

In view of the foregoing and in conclusion, Applicants submit that all of the pending claims are now in conditions for allowance.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,

  
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